

Application No. 09/897,275

REMARKS

Applicants respectfully request that the Examiner reinsert claims 19 and 20 into the present case, and prosecute these claims along with the pending claims. Applicants point out that claims 19 and 20 are further limiting, and that the Examiner has found allowable subject matter in claim 1, from which these claims depend. Because claim 1 is broader than claims 19 and 20, and because the Examiner has found allowable subject matter in claim 1, Applicants respectfully request that claims 19 and 20 be reinserted into the present case.

Entry of the amendments is respectfully requested.

Review and reconsideration on the merits are further requested.

Claims 1-18, 21 and 22 have been rejected under 35 USC §112, second paragraph.

In response, Applicants have the following comments.

With regard to the Examiner's statement that there is no distinction between "charge transporting molecule" and the generic "electrically conductive filler" in the independent claims, Applicants have the following comments. Applicants point out that the term "electrically conductive filler" is well known to one of ordinary skill in the art. Applicants point out that the present specification defines electrically conductive filler starting on page 14, line 30 to page 15, line 30, as a fine powder, conductivity-enhancing filler that is uniformly dispersed without large agglomerates in the polymer resins. Therefore, an electrically conductive filler is a conductivity-enhancing filler. Specific examples of fillers which are electrically conductive are set forth in the present specification and in the claims.

Applicants further submit that the term "charge transporting molecule" is also well known to one of ordinary skill in the art. A charge transporting molecule is defined as a molecule which allows the free charge photogenerated in the transport layer of a photoreceptor to be transported across the transport layer. Some charge transport molecules also permit injection of holes from the pigment into the charge generating layer and also transport them across the transport layer. Applicants provided patent numbers in the previous response which lists numerous charge transport molecules. In addition, charge transport molecules are set forth in the present specification at page 14, lines 1-5 and in the present claims.

Although the terms "charge transporting molecules" and "electrically conductive filler" are well known to one of ordinary skill in the art, Applicants have amended the independent

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claims in order to advance prosecution on the merits. Applicants have amended the claims by pointing out that an electrically conductive filler is different from a charge transporting molecule. Applicants point out that there is no overlap in the examples of electrically conductive fillers and charge transporting molecules set forth in the present specification.

The Examiner also states that the term "charge transport solution" and the term "filled solvent solution" are not different. Applicants point out that the "charge transport solution" is formed after mixing a charge transport molecule and an acetate in b). A filled solvent solution is formed after mixing an electrically conductive filler and a solvent in d). The steps of the present process, in embodiments, and the solution formed by each step, can be seen on page 14 of the present specification. Page 14, lines 17-23 provides an outline of an embodiment of the claim procedure.

Applicants further submit that Applicants are their own lexicographers. Applicants must use descriptive terms to show the different steps of the present process, and the solutions formed by each step. If the Examiner feels that there are more suitable terms to be used to point out the different steps and solutions formed, Applicants respectfully request that the Examiner provide Applicants with alternative, more appropriate terms.

The Examiner states that in claim 10, line 2, it is unclear what "said solvent" is referring to. In response, Applicants have amended claim 10 to point out that the solvent referred to is the solvent of (d).

The Examiner states that in claim 14, the meets and bounds of a "paralyzed polyacrylonitrile" are indefinite. In response, Applicants respectfully submit that one of ordinary skill in the art would readily know what is meant by the term "paralyzed" polyacrylonitrile. However, in order to advance prosecution on the merits, Applicants have amended claim 12 by deleting the term "paralyzed." Applicants assume that the Examiner is referring to claim 12 and not claim 14.

The Examiner states that in claim 14, there is no express antecedent basis in claim 12 for the term "carbon filler." In response, Applicants have amended claim 14 to depend from claim 13 instead of claim 12. Applicants appreciate the Examiner pointing out this mistake to Applicants.

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The Examiner states that in claim 17, line 3, Applicants may intend step d) as opposed to step c). In response, Applicants have amended claim 17 to replace "c)" with - - (d)- -. Applicants appreciate the Examiner pointing out Applicants' mistake.

In view of the above arguments and amendments, Applicants respectfully submit that all claims conform to the requirements of 35 USC §112, second paragraph, and respectfully request that the rejection of claims 1-18, 21 and 22 under 35 USC §112, second paragraph be withdrawn.

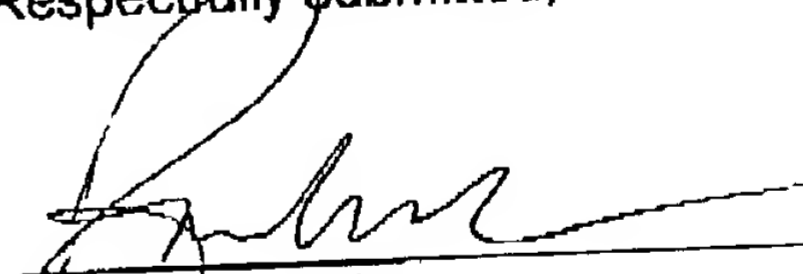
Applicants appreciate the Examiner's indication that claims 1-18, 21 and 22 would be allowable if rewritten or amended to overcome the rejection under 35 USC §112, second paragraph.

In view of the above arguments and amendments, Applicants respectfully submit that all claims are now in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682.

Respectfully submitted,


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